



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,907	10/23/2003	Robert Galli	P00573-US2	6537
3017	7590	12/16/2004	EXAMINER	
BARLOW, JOSEPHS & HOLMES, LTD. 101 DYER STREET 5TH FLOOR PROVIDENCE, RI 02903			CHOI, JACOB Y	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,907

Applicant(s)

GALLI, ROBERT

Examiner

Jacob Y Choi

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-19 is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6, 11 & 12 is/are rejected.
- 7) ☒ Claim(s) 2-4, 7-10 and 13-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/06/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 1/06/2004 was considered by the examiner.

Claim Objections

2. Claims 6 & 12 are objected to because of the following informalities: error appears on line 4 of claim 6 "*in said sidewall wherein said said closure ...*" & line 4 of claim 12 "*said opening in said sidewall wherein said said closure element ...*". Appropriate correction is required.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "*the channel having a bottom wall and a side wall extending upwardly between the bottom wall and the top surface with an opening in the side wall at the back end of the housing, the channel having mating formation adapted to slideably receive a secondary tool through the opening in the side wall*" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Note: submitted drawing figures only show a primary compartment of the pocketknife to be slideably inserted there of

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 11 & 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee (USPN 6,334,693).

Regarding claim 1, Lee discloses a housing (10) having a front end (17), a back end (opposite end of the front), a top surface (Figure 1), and a channel (15) configured within the top surface and extending inwardly from a peripheral edge of the back end of the housing, the channel having a bottom wall (34) and opposing side walls extending upwardly from the bottom wall, and further having an opening in the side wall at the back end of the housing (figure 3), the channel being configured to slidably receive a removable tool (37; figure 3), the channel and the removable tool having complementary formations for interfitting engagement thereof (Figure 1), a closure element (36) movably coupled to the back end of the housing, the closure element being movable between a first open position away from the rear opening in the sidewall of the channel, and a second closed position received in mated relation over the rear opening in the sidewall of the channel.

Note: claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Regarding claim 11, Lee discloses an outer casing (10) for enclosing primary device, the outer casing having a front end (17), a back end and a top surface (Figure 1), and a channel forming a secondary compartment (15) in the outer casing proximate to the back end of the housing, the channel having a bottom wall and a side wall extending upwardly between the bottom wall and the top surface with an opening in the

side wall at the back end of the housing, the channel having mating formations adapted to slideably receive a secondary tool through the opening in the side wall.

Regarding claim 12, Lee discloses a closure element (36) pivotably connected to the back end of the housing, the closure element being pivotably from a first open position to a second closed position over the opening in the sidewall wherein the closure element in the closed position retains the secondary tool in the channel.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5 & 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (USPN 6,080,698).

Regarding claim 5, Lee discloses a housing (10) having a primary compartment (15), the primary compartment being configured to receive a primary tool (37), the housing including a front end (17), a back end (opposite end of the front) and a top surface (Figure 1), and a channel (15) forming a secondary compartment in the housing proximate to the back end of the housing. Lee discloses the claimed invention except for the secondary compartment in the housing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the housing of Lee with additional / secondary compartment that is similar to the primary

compartment, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co., v. Bemis Co.*, 193 USPQ 8.

Regarding claim 6, Lee discloses a closure element (36) pivotably connected to the back end of the housing, the closure element being pivotably from a first open position to a second closed position over the opening in the sidewall wherein the closure element in the closed position retains the secondary tool in the channel.

Allowable Subject Matter

8. Claims 2-4, 7-10 & 13-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: the claims recite a secondary compartment having a front end, a back end, a top surface, and a channel configured within the top surface, the secondary compartment being configured to slideably receive the pocket knife in interfitting mated relation therein & the secondary compartment and the pocket knife having complementary formations for interfitting engagement thereof. Lee (USPN 6,334,693) teaches wrench / casing having channels & a closure element for a portable flashlight.

Because none of the reference cited discloses the combination of a case assembly having both primary compartment and a secondary compartment where secondary compartment is configured to slideably receive the pocket-knife in interfitting

mated relation & the casing comprising a closure element removably coupled to the back end of the housing proving an open and close operation, nor is there any motivation to combine them, the claims are deemed patentable over the prior art of record. Claims 17-19 are allowed.

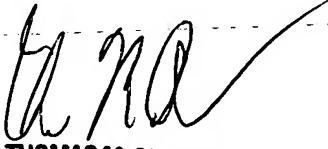
Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y Choi whose telephone number is (571) 272-2367. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JC


THOMAS M. SEMBER
PRIMARY EXAMINER